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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		99-110	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number	
on <u>April 3, 2006</u>		09/609,147	
Signature <u>V. S. Leliever</u>		Filed	
Typed or printed name <u>Veronika S. Leliever</u>		June 30, 2000	
		First Named Inventor	
		Jay S. Walker	
		Art Unit	
		3622	
		Examiner	
		Jeffrey Carlson	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)			
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>33,384</u>			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
		<u>Stephan J. Filipek</u> Signature	
		Stephan J. Filipek Typed or printed name	
		203.461.7252 Telephone number	
		April 3, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

<input checked="" type="checkbox"/>	*Total of <u>5</u> forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants: Walker et al.
Application No.: 09/609147
Filed: June 30, 2000
Title: METHOD AND APPARATUS FOR COMPENSATING
PARTICIPATION IN MARKETING RESEARCH
Attorney Docket No.: 99-110
Group Art Unit: 3622
Examiner: CARLSON, Jeffrey
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Examiner:

Applicants respectfully request Pre-Appeal Review of the rejections set forth in the Final Office Action mailed January 4, 2006 (Paper No. 20051226). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

Review is requested for the reasons recited below. Please note that, in the arguments, claim limitations are indicated by *italics* and the names of the cited references are underlined.

REMARKS**I. Introduction**

Claims 75-108 are pending, and Claims 75, 107 and 108 are the only independent claims. All pending claims stand rejected for allegedly being unpatentable over U.S. Patent No. 5,429,361 (hereinafter "Raven") in view of U.S. Patent No. 5,893,075 (hereinafter "Plainfield"), and further with various combinations of "Official Notice" taken with regard to certain claims. Raven and Plainfield have also been combined with U.S. Patent No. 5,971,850 (hereinafter "Liverance"), with U.S. Patent No. 5,941,772 (hereinafter "Paige"), and lastly with U.S. Patent No. 5,090,734 (hereinafter "Dyer") to reject various groups of claims.

Applicants thank the Examiner for withdrawing the 35 U.S.C. §101 rejection of Claims 75-106 in the Final Office Action.

II. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 75, 76, 79-81, 99, 102, 103, and 106-108 stand rejected for allegedly being obvious in view of Raven and Plainfield. We note that all of the obviousness rejections are based on Raven and Plainfield, either together, or in combination with other references, or with “Official Notice”, and thus our attention is focused on these two references herein.

Applicants respectfully submit that none of the independent Claims 75, 107 and 108 is obvious in view of Raven and Plainfield, either taken alone or in combination. In particular, neither Raven nor Plainfield provides any evidence of any of the following features of independent Claims 75, 107 and 108:

- *selecting the player to receive a survey question based on the (determined) gambling history (of the player),*
- *transmitting the survey question to the player via a slot machine, or*
- *providing determined compensation for a response to a survey question to the player via a slot machine.*

The Examiner has not provided evidence that could support the assertion that it was known or desirable to select a player to receive a survey question via a slot machine based on any information about the player (much less gambling history).

A. The Examiner’s Interpretation of Raven

The Examiner’s position is that Raven teaches all of the features of the pending independent claims except “compensating the player for responding to a survey.” [Final Action, page 3]. We disagree.

The Examiner asserts: “Raven et al. teaches programmed slot machines and networks which identify players and deliver promotional messages to the players [abstract].” [Final Action, page 2]. He also appears to find it relevant that Raven teaches that certain players may be designated as “special” based on “card data” and “treated differently” based on the amount the player is currently playing. [Final Action, pages 2-3]. The Examiner implies that the description in Raven of how players are “treated differently” is evidence suggesting that it was known that “special players” would receive particular messages via a slot machine. He further asserts: “Raven et al. teaches that messages may request that the player respond interactively to enter requested information [5:63-64]...” [Final Action, page 6]. The Examiner states:

As pointed out, Raven et al teaches identification of players as well as special treatment for certain players. It would have been obvious to one of ordinary skill at the time of the invention to have transmitted the disclosed interactive questions (taken to meet the broad language of a survey) to any desired individual or type of individual, including losing players. [Final Action, page 6].

Applicants respectfully assert that these conclusions are not supported by substantial evidence of record. Although we agree that Raven does not suggest compensating a selected player for responding to a survey, Raven does not teach all of the other features of independent Claims 75, 107 and 108. Further, Plainfield and Raven do not provide substantial evidence (or even a hint) of transmitting survey or marketing questions to anyone via a slot machine.

**1. The “Special Players” description in Raven Does Not Suggest
Receiving Messages At a Slot Machine**

Contrary to the Examiner’s assertion, Raven does not suggest that identifying a player has anything to do with delivering “promotional messages” (or any other type of message) to that player. There is no evidence in Raven of the desirability of selecting a particular player to receive a “promotional message.” Yet further, nothing in Raven remotely suggests either (i) providing messages or survey questions to a “special player,” or (ii) that whether a player is “special” has anything to do with any information transmitted to the player via a slot machine.

The portions of Raven relied upon by the Examiner teach only the following: If a player is “special,” signal to “casino personnel” that the player may be “worthy of special treatment.” Raven does not define what “special treatment” by “casino personnel” may mean. Also, Raven does not suggest that “special treatment” by “casino personnel” has anything to do with whether any type of message is sent to that player via a slot machine. To the contrary, the cited passage suggests that “casino personnel,” and not the slot machine itself, will provide some “special treatment” to a player.

**2. The “Player Reply Message” verbiage in Raven Does Not Suggest
Responding to a Survey**

Contrary to the Examiner’s interpretation, the “player reply message” discussed at Column 5, lines 63-64 of Raven is not evidence suggesting (i) a survey question or (ii) that “requested information” relates in any way to a survey question. There is no indication of any factual findings to support a conclusion that one of ordinary skill in the art would have interpreted the “player reply message” or the “requested information” of Raven as suggesting a survey question. The Examiner has conveniently concluded that “the disclosed interactive questions” is “taken to meet the broad language of a survey.” [Final Action, page 6] In fact, the only “requested information” contemplated by Raven is either a “personal identification number (PIN)” or a “credit request.” The “PIN” and “credit request” are “transmitted to the system for verification.” [See col. 8, lines 14-16 and col. 10, lines 49-62]. Nothing in Raven (or in the other cited art) supports a finding that a prompt for a “PIN” or a “credit request” would have suggested a *survey question* to one of only ordinary skill in the art.

**3. The “Promotional Message” verbiage of Raven Does Not
Suggest a Survey Question**

Nothing in Raven suggests that the “promotional messages” noted by the Examiner comprise any questions to a player, much less survey questions to which a player may respond. In fact, the “promotional messages” are distinguished in Raven from the “player reply messages.” This distinction would indicate that no “player reply” to a “promotional message” is provided or suggested by the Raven system. [See Column 5, lines 57-63]. Such evidence detracts from the Examiner’s interpretation and must also be considered, but the Examiner has not attempted to explain this clear distinction in the very evidence relied upon.

We therefore submit that the Examiner has failed to establish with substantial evidence that the specific types of messages described in Raven suggest survey questions transmitted to players, or the desirability of providing survey questions via a slot machine. Only impermissible hindsight has led the Examiner to view the specific description in Raven of a “player reply message” as somehow suggesting a *survey question*. There is no evidence that the Examiner’s generalized interpretation of the “player reply message” as “taken to meet the broad language of a survey” would have been interpreted in such manner by one of ordinary skill in the art at the time of the invention.

In view of the above remarks, we assert that the Examiner's interpretation of Raven is erroneous. We note that the entire case for rejection explicitly rests on Raven as evidence of selecting the player to receive a survey question based on the (determined) gambling history (of the player), and transmitting the survey question to the player via a slot machine. Consequently, a *prima facie* case of obviousness has not been established. As explained below, nothing in Plainfield would remedy these failures of the Examiner's obviousness rejection.

B. The Examiner's Interpretation of Plainfield

According to the Examiner: "Plainfield et al teaches surveying customers and rewarding the customers for responding as a means to create an incentive for participating in the marketing survey." [Final Action, page 3].

1. Plainfield Does Not Teach to Survey Identified Customers

The Examiner asserts that Plainfield teaches "surveying identified customers." This is false because Plainfield is directed to getting information from customers about whom nothing is known for the purpose of establishing a mailing list. Consequently, Plainfield does not suggest selecting any particular customer for a survey question, much less selecting a customer for a survey question based on information about the customer, much less gambling history. The evidence relied upon by the Examiner (Raven and Plainfield) cannot support such findings.

2. No Evidence of Motivation to Combine Raven and Plainfield

It would not have been obvious to combine Raven and Plainfield at least because these references are not analogous. The Examiner has not made any reasoned finding as to why one of ordinary skill would have considered the casino gaming system of Raven to be somehow analogous to the mailing list system of Plainfield. The mere fact that "special players" are mentioned in Raven and presenting survey questions is mentioned in Plainfield is not substantial evidence of the asserted motivation(s).

There is also no evidence in support of the Examiner's statement that "the reward for survey participation may be offered to those who are losing in order to keep their spirits up" was a known motivation at the time of invention. [Final Action, page 3] The Examiner has made a conclusory, subjective, and impermissible finding based on hindsight reasoning, using the benefit of Applicants' disclosure. We assert that such a finding cannot be supported by any objective evidence of record, and thus for at least this reason, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, we respectfully request reconsideration of the 35 U.S.C. §103(a) rejections of pending Claims 75, 81, and 106-108.

C. The "Official Notice" Rejections

1. Support is Lacking for the "Official Notice" Rejections

The Examiner combined Raven and Plainfield, and took "Official Notice" to reject claims 80, 82-97, 100 and 101 (Final Action, page 4). Although several references have been cited (Final Action, page 8) in an attempt to support the Examiner's general assertions as to how casinos "comp" players, these references still fail to support what "comp" has to do with compensation for a response to a survey question, or that the types of compensation recited in Claims 82-97 would have been known. Moreover,

there is still no evidence of record that compensation provided via a slot machine for a response comprising any of the following items would have been known to a person skilled in the art:

- erasing gambling losses (Claim 80);
- an increase in odds of winning in a game of chance (Claim 84);
- an increased prize table (Claim 85);
- an insurance protection against a loss (Claim 86);
- an ability to play a higher denomination currency gaming machine for a lower denomination currency (Claim 87);
- a free use of an extra slot in a multi-slot slot machine (Claim 88);
- activating an inactive payline (Claim 93);
- allowing the player to receive a prize corresponding to an outcome on an inactive payline (Claim 94); and
- retroactively activating a payline in exchange for gambling plays (Claim 95).

Consequently, we again traverse the Examiner's "Official Notice" assertions at least as applied to these claims, and respectfully request that these rejections be withdrawn.

2. No Motivation to Provide for Additional Features

No evidence has been provided to show that even if such subject matter was known it would have been obvious to modify the Raven system to provide for the asserted types of compensation. Accordingly, for at least these reasons, no *prima facie* case of obviousness has been established for claims 82-97. Further, since each of Claims 82-97 depends from independent Claim 75, these claims should be allowable for at least the same reasons.

D. The Remaining Obviousness Rejections

Dependent Claims 76, 77, 78, 84, 102, and 103 stand rejected as allegedly being obvious in view of Raven, Plainfield, and Liverance, and dependent Claim 104 stands rejected as allegedly being obvious in view of Raven, Plainfield, and Dyer. However, each of these claims depends from Claim 75, and thus the arguments provided above are equally applicable. Thus, these claims should be allowable for at least the same reasons.

III. Conclusion

Applicants respectfully request review and reversal of all of the 35 U.S.C. §103(a) rejections of the pending claims

April 3, 2006
Date

Respectfully submitted,


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